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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/904,471

**Applicant(s)**

DEWITT ET AL.

**Examiner**

ROB WU

**Art Unit**

3628

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,8-13,18,29,31-39,41-48 and 50-70 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1,3-5,8-13,18,29,31-39,41-48 and 50-70 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. In response filed June 08 2010, claims 1, 3-5, 8-13, 18, 29, 31-39, 41-48, 50-70 are pending in the current application.
2. The Examiner notes that claims 48 and 65 have a status identifier as Previously Presented. However, both claims display amendments made to the claims. In the interest of compact prosecution, the Examiner takes the claims as Currently Amended. Appropriate response is requested.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 08 2010 has been entered.

### ***Response to Arguments***

4. Applicant's arguments filed June 08 2010 have been fully considered but they are not persuasive.

5. The Applicant asserts that the "Examiner has shown no teaching or suggestion for why one of ordinary skill in the art would combine the numerous bits and pieces of references as the Examiner has done" and that "although KSR stated that references can be combined even if there is no specific suggestion in the reference to combine the teaching, there still must be some motivation to combine", therefore the Examiner has inappropriately rejected the claims. The Examiner respectfully disagrees.

The Court in KSR starts off with "we begin by rejecting the rigid approach of the Court of Appeals" of using the TSM test. (550 U.S. 398, 127 S.Ct. 1727) The Court states that "when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." And "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*, at 13. The Court then found "[h]elpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the TSM test is incompatible with our precedents." *Id.*, at 15.

Therefore the Applicant's argument of "must" providing some motivation to combine goes against the Court's decision of not applying a rigid and mandatory formula, obviousness can be found when old elements each performing the same function it had been known to perform are arranged and the arrangement results are predictable. In the present case, the elements are all well known in the respectful mailing art and the combination of the known elements does not destroy the functions of each of the elements and the combination produces no unpredictable results.

Assume arguing that some motivation to combine must be provided, Gendreau discloses that the invention is intended to encompass all modifications, alterations and substitutions within the spirit and scope of the disclosed embodiments. [0051] Bodie et al disclose similar language (col 3: lines 24-26) that provide motivation to combine the elements to provide a streamlined automated mail processing apparatus.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 4, 10-13, 29, 31-35, 39, 41,48, 50-56, 62-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub No. 2001/0034608 to Gendreau in view of U.S. Pat No. 5,731,574 to Bodie et al in further view of U.S. Pat No 6,292,709 to Uhl et al.

**Referring to claim 1:**

An apparatus for processing mail, comprising:

Gendreau discloses

A transport for conveying mail along a transport path; (Fig 1), [0022]

A scale positioned along the transport path for weighing the pieces of mail;

[0022]

An imaging station positioned along the transport path for scanning the pieces of mail to obtain image data for the mail to determine address information of the recipients of the pieces; [0022], [0032]

A labeler positioned along the transport path for applying labels to the mail;  
[0034]

A processor operable to determine postal information for a piece of mail in response to the determined address information and weight of the piece of mail; [0033]

A printer operable to print the determined information onto the label for the piece;  
[0034]

Gendreau does not expressly disclose that the postage information is determined and printed on the label. Gendreau does disclose that the delivery cost for various parcel carriers is determined and a shipping label for the selected parcel carrier is printed. [0033], [0034]

Bodie et al disclose an example of the shipping label for the United States Postal Service which shows the postage information for a piece of mail. (Fig 3)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to determine and print the postage information on a piece as disclosed by Bodie et al if mail if the United States Postal Service is selected as the parcel carrier since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, in the present case, the determining and printing step as disclosed by Gendreau would have been performed the same no

matter which parcel carrier is selected and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau does not expressly disclose that if the address information is not determined for a mail piece within a predetermined time period, the printer prints an identification code onto the label.

Uhl et al disclose that if the address on a mailpiece cannot be determined, then an ID number is printed onto the mailpiece as a barcode. (col 2: lines 45-50)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include printing an identification code onto a mailpiece if the address information cannot be determined as disclosed by Uhl et al since the claimed invention is merely a combination of old elements, and in the combination the determining and printing elements as disclosed by Gendreau would have been performed the same with the identification element as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau does not expressly disclose a verifier operable to scan the label applied by the labeler to verify that the postage information printed by the printer was printed properly.

Bodie et al disclose scanning the label to verify if the postage information printed by the printer was printed properly. (col 2: lines 60-67; col 3: lines 1-15)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include the verification process as

disclosed by Bodie et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. In the present case, the verification process as disclosed by Bodie et al would have functioned the same when combined with the mail processing system of Gendreau and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

and

A sorter for sorting mailpieces in response to the determined address information and weight. [0035].

Furthermore, one having ordinary skill in the art at the time the invention was made would have been motivated to combine Gendreau, Bodie et al and Uhl et al to provide a streamlined automated mail processing apparatus.

**Referring to claim 3:**

Gendreau discloses the apparatus of claim 1 wherein the imaging station comprises a line scan camera for scanning the piece of mail at a plurality of discrete points to create a set of image data representative of at least a portion of the piece of mail. [0032], [0033]

**Referring to claim 4:**

Gendreau discloses the apparatus of claim 3 wherein the imaging station comprises an imaging computer for processing the image data to determine the address information. [0032]

**Referring to claim 10:**



Gendreau discloses the apparatus of claim 1 wherein the transport comprises a roller bed for conveying the pieces of mail in a generally horizontal orientation. (Fig 1)

**Referring to claim 11:**

Gendreau does not expressly disclose a verifier operable to scan the pieces and determine whether the postage information was properly printed.

Bodie et al disclose scanning the label to verify if the postage information printed by the printer was printed properly. (col 2: lines 60-67; col 3: lines 1-15)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include the verification process as disclosed by Bodie et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. In the present case, the verification process as disclosed by Bodie et al would have functioned the same when combined with the mail processing system of Gendreau and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

**Referring to claim 12:**

Gendreau disclose wherein the verifier comprises a line scan camera for scanning the pieces of mail at a plurality of discrete points to create image data representative of at least a portion of the pieces of mail. [0037]

**Referring to claim 13:**

A method for processing mail, comprising the steps of:

Gendreau discloses

Scanning a piece of mail to determine address information for the recipient;  
[0022], [0032]

Conveying the piece of mail to a scale; (Fig 1), [0022]

Weighing the piece; [0022]

Determining the appropriate postal information based on the determined address information and the determined weight of the piece; [0033]

Adhering a label onto the piece; [0034]

Printing postal information on the label; [0034]

Gendreau does not expressly disclose that the postage information is determined and printed on the label. Gendreau does disclose that the delivery cost for various parcel carriers is determined and a shipping label for the selected parcel carrier is printed. [0033], [0034]

Bodie et al disclose an example of the shipping label for the United States Postal Service which shows the postage information for a piece of mail. (Fig 3)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to determine and print the postage information on a piece as disclosed by Bodie et al if mail if the United States Postal Service is selected as the parcel carrier since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, in the present case, the determining and printing step as disclosed by Gendreau would have been performed the same no

matter which parcel carrier is selected and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau does not expressly disclose that if the address information is not determined for a mail piece within a predetermined time period, the printer prints an identification code onto the label.

Uhl et al disclose that if the address on a mailpiece cannot be determined, then an ID number is printed onto the mailpiece as a barcode. (col 2: lines 45-50)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include printing an identification code onto a mailpiece if the address information cannot be determined as disclosed by Uhl et al since the claimed invention is merely a combination of old elements, and in the combination the determining and printing elements as disclosed by Gendreau would have been performed the same with the identification element as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau does not expressly disclose a scanning the printed postage information to verify that the postage information was properly printed.

Bodie et al disclose scanning the label to verify if the postage information printed by the printer was printed properly. (col 2: lines 60-67; col 3: lines 1-15)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include the verification process as disclosed by Bodie et al since the claimed invention is merely a combination of old

elements, and in the combination each element merely would have performed the same function as it did separately. In the present case, the verification process as disclosed by Bodie et al would have functioned the same when combined with the mail processing system of Gendreau and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

and

Sorting the piece of mail in response to the determined address information and the determined weight. [0035]

Furthermore, one having ordinary skill in the art at the time the invention was made would have been motivated to combine Gendreau, Bodie et al and Uhl et al to provide a streamlined automated mail processing apparatus.

**Referring to claim 29:**

Gendreau discloses the apparatus of claim 1 comprising a sorter for sorting a piece of mail into one of a plurality of bins in response to the determined weight for the piece. [0035], [0048]

**Referring to claim 31:**

An apparatus for processing mail, comprising:

A transport for conveying mail along a path; (Fig 1), [0022]

A scale positioned along the path for weighing the pieces of mail; [0022]

A scanner positioned along the transport path for scanning the pieces of mail to obtain image data for the mail to determine address information of the recipients of the pieces; [0022]

A labeler positioned along the transport path for applying labels to the pieces of mail; [0034]

A processor operable to determine information for a piece of mail in response to the weight of the piece of mail; [0033]

A printer operable to print the determined information onto the label for the piece; [0034]

Gendreau does not expressly disclose that the postage information is determined and printed on the label. Gendreau does disclose that the delivery cost for various parcel carriers is determined and a shipping label for the selected parcel carrier is printed. [0033], [0034]

Bodie et al disclose an example of the shipping label for the United States Postal Service which shows the postage information for a piece of mail. (Fig 3)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to determine and print the postage information on a piece as disclosed by Bodie et al if mail if the United States Postal Service is selected as the parcel carrier since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, in the present case, the determining and printing step as disclosed by Gendreau would have been performed the same no matter which parcel carrier is selected and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau does not expressly disclose that if the address information is not determined for a mail piece within a predetermined time period, the printer prints an identification code onto the label.

Uhl et al disclose that if the address on a mailpiece cannot be determined, then an ID number is printed onto the mailpiece as a barcode. (col 2: lines 45-50)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include printing an identification code onto a mailpiece if the address information cannot be determined as disclosed by Uhl et al since the claimed invention is merely a combination of old elements, and in the combination the determining and printing elements as disclosed by Gendreau would have been performed the same with the identification element as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau does not expressly disclose a verifier operable to scan the label applied by the labeler to verify that the postage information printed by the printer was printed properly.

Bodie et al disclose scanning the label to verify if the postage information printed by the printer was printed properly. (col 2: lines 60-67; col 3: lines 1-15)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include the verification process as disclosed by Bodie et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same

function as it did separately. In the present case, the verification process as disclosed by Bodie et al would have functioned the same when combined with the mail processing system of Gendreau and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

and

A sorter operable to sort the piece of mail into one of a plurality of bins based on the weight of the piece of mail [0035]

Furthermore, one having ordinary skill in the art at the time the invention was made would have been motivated to combine Gendreau, Bodie et al and Uhl et al to provide a streamlined automated mail processing apparatus.

**Referring to claim 32:**

Gendreau discloses the apparatus of claim 31 wherein the processor determines the postage information in response to the determined recipient's address information and the weight of the piece. [0033]

**Referring to claim 33:**

Gendreau discloses the apparatus of claim 31 wherein the sorter is operable to sort the piece of mail based on the weight of the piece of mail and the address information for the recipient of the piece of mail. [0035]

**Referring to claim 34:**

Gendreau discloses the apparatus of claim 31 wherein the scanner comprises a line scan camera for scanning the piece of mail at a plurality of discrete points to create

a set of image data representative of at least a portion of the piece of mail. [0032],  
[0033]

**Referring to claim 35:**

Gendreau discloses the apparatus of claim 34 wherein the scanner comprises an imaging computer for processing the image data to determine the recipient of the piece.  
[0032]

**Referring to claim 39:**

Gendreau discloses the apparatus of claim 31 wherein the transport is configured to transport the pieces of mail in a generally horizontal orientation. (Fig 1)

**Referring to claim 41:**

Gendreau disclose wherein the verifier comprises a line scan camera for scanning the pieces of mail at a plurality of discrete points to create image data representative of at least a portion of the pieces of mail. [0037]

**Referring to claim 48:**

A method for processing mail, comprising the steps of:

Gendreau discloses

scanning pieces of mail to determine address data for the pieces; [0022], [0032]

conveying the pieces of mail along a transport path to a scale; (Fig 1), [0022]

weighing the pieces; [0022]

conveying the pieces along the transport path to a labeler; (Fig 1)



Gendreau discloses determining the cost for delivering the pieces based on the determined weight of each piece as part of the delivery information and printing on and adhering labels with the shipping information on the mail pieces. [0033], [0034]

Gendreau does not expressly disclose that the postage information is determined and printed on the label. Gendreau does disclose that the delivery cost for various parcel carriers is determined and a shipping label for the selected parcel carrier is printed. [0033], [0034]

Bodie et al disclose an example of the shipping label for the United States Postal Service which shows the postage information for a piece of mail. (Fig 3)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to determine and print the postage information on a piece as disclosed by Bodie et al if mail if the United States Postal Service is selected as the parcel carrier since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, in the present case, the determining and printing step as disclosed by Gendreau would have been performed the same no matter which parcel carrier is selected and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau does not expressly disclose that if the address information is not determined for a mail piece within a predetermined time period, the printer prints an identification code onto the label.

Uhl et al disclose that if the address on a mailpiece cannot be determined, then an ID number is printed onto the mailpiece as a barcode. (col 2: lines 45-50)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include printing an identification code onto a mailpiece if the address information cannot be determined as disclosed by Uhl et al since the claimed invention is merely a combination of old elements, and in the combination the determining and printing elements as disclosed by Gendreau would have been performed the same with the identification element as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau discloses

Conveying the piece along the transport path to a sorter; [0035] and

Sorting the piece into one of a plurality of bins. [0035]

Furthermore, one having ordinary skill in the art at the time the invention was made would have been motivated to combine Gendreau, Bodie et al and Uhl et al to provide a streamlined automated mail processing apparatus.

**Referring to claim 50:**

Gendreau discloses the apparatus of claim 1 wherein the transport is configured to convey a batch of mixed mail of various heights and thicknesses [0037], [0039]

**Referring to claim 51:**

Gendreau discloses the apparatus of claim 50 wherein the transport is a substantially horizontal transport configured to convey the mail pieces to the imaging station in a substantially horizontal orientation, (Fig 1)

**Referring to claim 52:**

Gendreau discloses the method of claim 13 comprising the step of providing a batch of mixed mail having pieces of various size. [0037], [0039]

**Referring to claim 53:**

Gendreau discloses the method of claim 13 wherein the step of conveying comprises conveying the piece of mail in a generally horizontal orientation. (Fig 1)

**Referring to claim 54:**

Gendreau discloses the method of claim 53 wherein the step of adhering a label comprises displacing the piece of mail in a generally horizontal orientation to a labeler and adhering a label to the piece of mail while the piece of mail is in a generally horizontal orientation. (Fig 1)

**Referring to claim 55:**

Gendreau discloses the apparatus of claim 31 wherein the transport comprises a generally horizontal surface configured to receive and convey mail pieces in a generally horizontal orientation. (Fig 1)

**Referring to claim 56:**

Gendreau discloses that the system can handle mail pieces of various sizes [0037], [0039]. Gendreau does not expressly disclose a feeder configured to accommodate a mixed batch of mail having pieces of various size. However, it would

have been obvious at the time of the invention for Gendreau to have a feeder capable of accommodating a mixed batch of mail having pieces of various size since the conveyor and the computer system 18 is capable of shipping mixed size mail items

**Referring to claim 62:**

Gendreau discloses the method of claim 48 comprising the step of providing a batch of mixed mail having pieces of various size. [0037], [0039]

**Referring to claim 63:**

Gendreau discloses the method of claim 48 wherein the step of conveying comprises conveying the piece of mail in a generally horizontal orientation. (Fig 1)

**Referring to claim 64:**

Gendreau discloses the method of claim 63 wherein the step of adhering a label comprises displacing the piece of mail in a generally horizontal orientation to a labeler and adhering a label to the piece of mail while the piece of mail is in a generally horizontal orientation wherein the step of adhering comprises vertically displacing a label toward the piece of mail. (Fig 1)

**Referring to claim 65:**

An apparatus for processing mail, comprising:

Gendreau discloses

a transport configured for convey mail in a generally horizontal orientation along a path; (Fig 1), [0022]

a scale positioned along the path for weighing the pieces of mail; [0022]

a scanner positioned along the transport path for scanning the pieces of mail to determine address information of the recipients of the pieces; [0022], [0032]

a labeler positioned along the transport path for applying labels to the pieces of mail; [0034] and

a processor operable to selectively determine postal information for a piece of mail in response to the weight of the piece of mail; [0033], [0034]

Gendreau does not expressly disclose that postal information is printed onto select labels in response to the determined postal information and select other labels are printed with identification numbers instead of postal information.

Gendreau discloses that an appropriate shipping carrier is selected from plurality of parcel carriers such as Federal Express®, United Parcel Service® or United States Postal Service. [0033]

Bodie et al disclose an example of the shipping label for the United States Postal Service which shows the postage information for a piece of mail. (Fig 3)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to determine and print the postage information on a piece as disclosed by Bodie et al if mail if the United States Postal Service is selected as the parcel carrier since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, in the present case, the determining and printing step as disclosed by Gendreau would have been performed the same no

matter which parcel carrier is selected and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau does not expressly disclose that if the address information is not determined for a mail piece within a predetermined time period, the printer prints an identification code onto the label.

Uhl et al disclose that if the address on a mailpiece cannot be determined, then an ID number is printed onto the mailpiece as a barcode. (col 2: lines 45-50)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include printing an identification code onto a mailpiece if the address information cannot be determined as disclosed by Uhl et al since the claimed invention is merely a combination of old elements, and in the combination the determining and printing elements as disclosed by Gendreau would have been performed the same with the identification element as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Furthermore, one having ordinary skill in the art at the time the invention was made would have been motivated to combine Gendreau, Bodie et al and Uhl et al to provide a streamlined automated mail processing apparatus.

**Referring to claim 66:**

Gendreau discloses the apparatus of claim 65 wherein the processor is operable to determine the postal information for the piece in response to the weight and the determined address information. [0033]

**Referring to claim 67:**

Gendreau discloses the apparatus of claim 65 wherein the labeler is configured to receive the piece of mail in a generally horizontal orientation and apply the label in a generally horizontal orientation. (Fig 1)

**Referring to claim 68:**

Gendreau discloses the apparatus of claim 65 comprising a sorter for sorting the piece of mail into one of a plurality of bins based on the weight or determine address information. [0034]

**Referring to claim 69:**

Gendreau discloses the apparatus of claim 65 comprising a sorter for sorting the piece of mail in response to the determined postal information. [0035]

8. Claims 5, 8, 36, 37, 42-47, 57-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gendreau in view of Bodie et al in further view of U.S. Pat No. 7,060,926 to Edmonds in further view of Uhl et al.

**Referring to claim 5:**

Gendreau disclose that the address information is read by an imaging device [0032]. Gendreau does not expressly disclose that the imaging device utilizing OCR to determine the address and the Zipcode of the recipient of the piece, and the piece is rejected if the determined address and Zipcode do not properly correlate. Edmonds disclose using an OCR system to read the address on mailpieces (col 1: lines 62-64) and if the address cannot be read then the mail piece is rejected. (col 2 lines 3-4)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to utilize OCR with the imaging device to read the address information on the mailpiece and to reject the mailpiece if the address and zipcode do not match. Gendreau would be motivated to do so because OCR is well known in the arts for reading address information from mailpieces and to ensure that the address information on the mailpiece is correct to properly calculate shipping charges.

**Referring to claim 8:**

Gendreau does not expressly disclose a reject bin for receiving pieces for which the recipient's address is not determined. Edmonds discloses that if the OCR reads an incorrect barcode, the letter is then rejected by the OCR. (col 2: lines 3-4)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to reject a mailpiece if incorrect information is shown on the mailpiece. Gendreau would be motivated to perform such step to ensure that the shipping costs for the mailpieces can be determined properly.

**Referring to claim 36:**

Gendreau disclose that the address information is read by an imaging device [0032]. Gendreau does not expressly disclose that the imaging device utilizing OCR to determine the address and the Zipcode of the recipient of the piece, and the piece is rejected if the determined address and Zipcode do not properly correlate. Edmonds disclose using an OCR system to read the address on mailpieces (col 1: lines 62-64) and if the address cannot be read then the mail piece is rejected. (col 2 lines 3-4)



Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to utilize OCR with the imaging device to read the address information on the mailpiece and to reject the mailpiece if the address and zipcode do not match. Gendreau would be motivated to do so because OCR is well known in the arts for reading address information from mailpieces and to ensure that the address information on the mailpiece is correct to properly calculate shipping charges.

**Referring to claim 37:**

Gendreau does not expressly disclose a reject bin for receiving pieces for which the recipient's address is not determined. Edmonds discloses that if the OCR reads an incorrect barcode, the letter is then rejected by the OCR. (col 2: lines 3-4)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to reject a mailpiece if incorrect information is shown on the mailpiece. Gendreau would be motivated to perform such step to ensure that the shipping costs for the mailpieces can be determined properly.

**Referring to claim 42:**

An apparatus for processing mail, comprising:

Gendreau discloses

A transport for conveying mail along a transport path; (Fig 1), [0022]

A scale positioned along the transport path for weighing the pieces of mail;

[0022]

A scanner positioned along the transport path for scanning the pieces of mail to determine address information of the recipients of the pieces; [0022], [0032]

A labeler positioned along the transport path for applying labels to the mail; [0034]

Gendreau does not expressly disclose applying labels to some but not all of the pieces of mail conveyed along the transport path.

Edmonds discloses that if the OCR reads an incorrect barcode, the letter is then rejected by the OCR. (col 2: lines 3-4)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include the rejection feature as disclosed by Edmonds since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. In the present case, Gendreau combined with Edmonds would reject the mail pieces that could not be properly read by OCR and therefore Gendreau's invention would not be able to determine the delivery cost of the mail piece and apply a label, thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

A processor operable to selectively determine postal information for a piece of mail in response to the weight of the piece of mail; [0033] and

A printer operable to selectively print the determined information onto the label for the piece; [0034]

Gendreau does not expressly disclose that the postage information is determined and printed on the label. Gendreau does disclose that the delivery cost for various parcel carriers is determined and a shipping label for the selected parcel carrier is printed. [0033], [0034]

Bodie et al disclose an example of the shipping label for the United States Postal Service which shows the postage information for a piece of mail. (Fig 3)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to determine and print the postage information on a piece as disclosed by Bodie et al if mail if the United States Postal Service is selected as the parcel carrier since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, in the present case, the determining and printing step as disclosed by Gendreau would have been performed the same no matter which parcel carrier is selected and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau does not expressly disclose that if the address information is not determined for a mail piece within a predetermined time period, the printer prints an identification code onto the label.

Uhl et al disclose that if the address on a mailpiece cannot be determined, then an ID number is printed onto the mailpiece as a barcode. (col 2: lines 45-50)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include printing an identification code

onto a mailpiece if the address information cannot be determined as disclosed by Uhl et al since the claimed invention is merely a combination of old elements, and in the combination the determining and printing elements as disclosed by Gendreau would have been performed the same with the identification element as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Furthermore, one having ordinary skill in the art at the time the invention was made would have been motivated to combine Gendreau, Bodie et al and Uhl et al to provide a streamlined automated mail processing apparatus.

**Referring to claim 43:**

Gendreau discloses the apparatus of claim 42 comprising a sorter operable to sort the piece of mail into one of a plurality of bins based on the weight of the piece of mail. [0035], [0048]

**Referring to claim 44:**

Gendreau discloses the apparatus of claim 42 wherein the processor is operable to selectively determine the postage information for the piece of mail in response to the recipient of the piece of mail. [0033]

**Referring to claim 45:**

A method for processing mail, comprising the steps of:

Gendreau discloses

scanning a piece of mail to determine the recipient; [0022], [0032]

conveying the piece of mail along a transport path to a scale; (Fig 1), [0022]

weighing the pieces; [0022]

conveying the piece along the transport path to a labeler; [0034]

Gendreau does not expressly disclose applying labels to some but not all of the pieces of mail conveyed along the transport path.

Edmonds discloses that if the OCR reads an incorrect barcode, the letter is then rejected by the OCR. (col 2: lines 3-4)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include the rejection feature as disclosed by Edmonds since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. In the present case, Gendreau combined with Edmonds would reject the mail pieces that could not be properly read by OCR and therefore Gendreau's invention would not be able to determine the delivery cost of the mail piece and apply a label, thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

determining postal information for a piece of mail in response to the weight of the piece of mail; [0033] and

printing the determined information onto the selected label [0034]

Gendreau does not expressly disclose that the postage information is determined and printed on the label. Gendreau does disclose that the delivery cost for various parcel carriers is determined and a shipping label for the selected parcel carrier is printed. [0033], [0034]

Bodie et al disclose an example of the shipping label for the United States Postal Service which shows the postage information for a piece of mail. (Fig 3)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to determine and print the postage information on a piece as disclosed by Bodie et al if mail if the United States Postal Service is selected as the parcel carrier since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, in the present case, the determining and printing step as disclosed by Gendreau would have been performed the same no matter which parcel carrier is selected and thus one ordinary skill in the art would have recognized that the results of the combination were predictable.

Gendreau does not expressly disclose that if the address information is not determined for a mail piece within a predetermined time period, the printer prints an identification code onto the label.

Uhl et al disclose that if the address on a mailpiece cannot be determined, then an ID number is printed onto the mailpiece as a barcode. (col 2: lines 45-50)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include printing an identification code onto a mailpiece if the address information cannot be determined as disclosed by Uhl et al since the claimed invention is merely a combination of old elements, and in the combination the determining and printing elements as disclosed by Gendreau would have been performed the same with the identification element as it did separately.

Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Furthermore, one having ordinary skill in the art at the time the invention was made would have been motivated to combine Gendreau, Bodie et al and Uhl et al to provide a streamlined automated mail processing apparatus.

**Referring to claim 46:**

Gendreau discloses the method of claim 45 wherein the step of determining the appropriate postage comprises determining the appropriate postage based on the determined address and the determined weight of the piece. [0033]

**Referring to claim 47:**

Gendreau discloses sorting the packages by carrier [0034]. Gendreau does not expressly disclose sorting the piece according to the recipient's address. However, it would have been obvious at the time of the invention for Gendreau to sort according to the recipient's address. Gendreau would have been motivated to do so to facilitate shipping of the packages.

**Referring to claim 57:**

Gendreau discloses the apparatus of claim 42 wherein the transport comprises a generally horizontal surface configured to receive and convey mail pieces in a generally horizontal orientation. (Fig 1)

**Referring to claim 58:**

Gendreau discloses that the system can handle mail pieces of various sizes [0037], [0039]. Gendreau does not expressly disclose a feeder configured to

accommodate a mixed batch of mail having pieces of various size. However, it would have been obvious at the time of the invention for Gendreau to have a feeder capable of accommodating a mixed batch of mail having pieces of various size since the conveyor and the computer system 18 is capable of shipping mixed size mail items.

**Referring to claim 59:**

Gendreau discloses the method of claim 45 comprising the step of providing a batch of mixed mail having pieces of various size. [0037], [0039]

**Referring to claim 60:**

Gendreau discloses the method of claim 45 wherein the step of conveying comprises conveying the piece of mail in a generally horizontal orientation. (Fig 1)

**Referring to claim 61:**

Gendreau discloses the method of claim 60 wherein the step of adhering a label comprises displacing the piece of mail in a generally horizontal orientation to a labeler and adhering a label to the piece of mail while the piece of mail is in a generally horizontal orientation. (Fig 1)

9. Claims 9, 18 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gendreau in view of Bodie et al in further view of U.S. Pat No. 5,308,932 to Manduley et al.

**Referring to claim 9:**



Gendreau does not expressly disclose a re-orientor operable to re-orient the mail as the feeder feeds the mail into the transport. Manduley et al disclose an orientor to orient a mailpiece in conventional manner. (col 3: lines 16-20)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include a re-orientor to re-orient the mail as the mail is fed into the transport. Gendreau would have been motivated to perform such step to ensure that the mailpiece is oriented correctly for address determination and shipping label application.

**Referring to claim 18:**

Gendreau does not expressly disclose a step of serially feeding the piece from a stack of mail in an input bin. However, Manduley et al disclose serially feeding the mailpieces from a stack of mail in an input bin. (col 4: lines 16-18)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to serially feed mail pieces from a stack of mail in an input bin. Gendreau would be motivated to do so because the mail pieces in Gendreau's invention are already being fed serially and feeding mail pieces from a stack of mail in an input bin is well known in the arts.

**Referring to claim 38:**

Gendreau does not expressly disclose a re-orientor operable to re-orient the mail as the feeder feeds the mail into the transport. Manduley et al disclose an orientor to orient a mailpiece in conventional manner. (col 3: lines 16-20)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to include a re-orientor to re-orient the mail as the mail is fed into the transport. Gendreau would have been motivated to perform such step to ensure that the mailpiece is oriented correctly for address determination and shipping label application.

10. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gendreau in view of Bodie et al in further view of Uhl et al in further view of U.S. Pat No 6,311,892 to O'Callaghan et al.

Gendreau does disclose that the delivery cost for various parcel carriers is determined and a shipping label for the selected parcel carrier is printed. [0033], [0034]

Uhl et al disclose that the image of the mailpiece is stored along with the ID Number if the address information cannot be determined. (col 2: lines 45-52)

Gendreau and Uhl et al do not expressly disclose wherein the weight information is correlated with the identification number so that the postage information can be determined for the piece without re-weighing the piece, once the address information is determined for the piece.

O'Callaghan et al disclose that the weight of the mailpiece and the associated numeric identification number that is applied to the mailpiece are recorded. (col 4: lines 66-67; col 5: lines 1-3)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gendreau to combine the association of the

mailpiece information with a ID code as disclosed by Uhl et al and O'Callaghan and use the information to determine postage information since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROB WU whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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